

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 5/8/00

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Opposition No. 103,997

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CITABLE AS PRECEDENT OF THE
TTAB MAY 8, 00

Converse, Inc.

v.

Worldwide Kids
Associates, Ltd.

Before Quinn, Rogers and McLeod, Administrative Trademark
Judges.

By the Board:

Converse, Inc. ("opposer") has filed an opposition
against Worldwide Kids Associates, Ltd.'s ("applicant")
intent-to-use application to register the mark "TEXAS KIDS"
and design, as shown below, with the words "TEXAS KIDS"
being disclaimed apart from the mark as shown, for
"footwear, headwear, and clothing for children, women, and
men, namely, pants, shorts, shirts, blouses, skirts,
jackets, overalls, warm-up suits, sweatshirts, socks, hats,
leotards, and dresses."¹

As grounds for the opposition, opposer alleges that it has previously used and registered a series of marks containing a five-pointed star design in connection with shoes, clothing, sporting goods, bags and related articles. Opposer's pleaded registrations are for the following marks:

U.S. Registration No. 741,662, issued December 4, 1962, for "canvas-topped, rubber-soled, athletic shoes."

U.S. Registration No. 924,169, issued November 23, 1971, as amended, for "golf shoes, track shoes, wrestling shoes, baseball shoes, football shoes, skate scabbards, ankle supports, teeth guards, hockey pucks, air floats, air mattresses, hunting boots, fishing boots, industrial boots, rubber boots, tennis shoes, basketball shoes, boat shoes, general purpose athletic sneakers, casual shoes, wading sandals, jackets, trousers, parkas, shirts, overalls, hats, raincoats, and suspenders."

¹ Application Serial No. 74/632,112, filed February 9, 1995, alleging a bona fide intent to use the mark in commerce.

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U.S. Registration No. 1,053,338, issued November 23, 1976,
for "canvas and imitation leather topped soft sole athletic
shoes and casual shoes."

U.S. Registration No. 1,708,480, issued November 29, 1977,
for "footwear."

U.S. Registration No. 1,078,481, issued November 29, 1997,
for "footwear."

U.S. Registration No. 1,116,665, issued April 17, 1979,
for "footwear, shirts, socks and warm-up suits."

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U.S. Registration No. 1,138,468, issued August 5, 1980,
for "footwear."

U.S. Registration No. 1,138,469, issued August 5, 1980,
for "footwear."

U.S. Registration No. 1,146,876, issued February 10, 1981,
for "footwear."

U.S. Registration No. 1,490,262, issued May 31, 1988, for
"athletic footwear."

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U.S. Registration No. 1,521,010, issued January 17, 1989,
for "footwear."

U.S. Registration No. 1,632,413, issued January 22, 1991,
for "footwear, socks and warm-up suits."

U.S. Registration No. 1,654,951, issued August 27, 1991,
for "clothing, namely, footwear."

U.S. Registration No. 1,789,476, issued August 24, 1993,
for "footwear."

U.S. Registration No. 1,868,414, issued December 20, 1994, for "footwear."

Opposer further alleges that it has promoted and sold its goods in interstate commerce under its five-pointed star design since long prior to any alleged use by applicant of the mark for which it seeks registration; and that applicant's mark so resembles opposer's registered marks as to be likely to cause confusion, or to cause mistake or to deceive.

Applicant has filed an answer denying the salient allegations in the notice of opposition.

This case now comes up on applicant's motion for summary judgment and opposer's cross-motion for summary judgment, both on opposer's pleaded claim under Section 2(d) of the Trademark Act. The parties have fully briefed the motions.²

In support of its motion for summary judgment, applicant argues, among other things, that, because of the dissimilarity in the marks of the parties and the absence of any actual confusion, applicant is entitled to entry of judgment in its favor on the issue of likelihood of confusion. In particular, applicant argues that the star design in applicant's mark is

² The Board has considered applicant's reply brief on its motion for summary judgment. See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

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merely a background element and is simply incidental to the dominant words "TEXAS KIDS." Further, applicant maintains that the design component of its mark contains multiple elements, which clearly distinguishes its mark from opposer's marks, i.e., the stylized acronym TK and the overall Western cattle brand motif. Applicant also argues that the five pointed star design contained in its mark was selected because of its connotation relating to the State of Texas and in order to link the name "TEXAS KIDS" to the image of the Lone Star State embodied in the five-pointed star in the Texas state flag. Finally, applicant argues that the co-existence of a large number of third-party registrations for marks which contain five-pointed stars for footwear demonstrates that the star design is weak for such goods.

As evidence in support of its motion, applicant has submitted: (1) the declaration of Marilyn Wohlstadter, applicant's president, and accompanying exhibits, illustrating use of applicant's mark and explaining why applicant chose a five-pointed star design to be part of the design element of its mark; excerpts from the 1996-97 Texas Almanac demonstrating how the five-pointed star is used to refer to the state of Texas and/or the Lone Star State; and copies of third-party registrations containing a five-pointed star design to support applicant's claim that star designs are widely used by third parties in connection with footwear.

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In its response and cross-motion for summary judgment, opposer argues that there are no genuine issues of material fact and that opposer is entitled to judgment as a matter of law because the marks in their entireties are confusingly similar, the goods of the parties are the same in part and are otherwise highly related, that the channels of trade and potential consumers are the same, and that opposer's five-pointed star design as displayed in the marks of its pleaded registrations is famous. Specifically, opposer argues that the prominent five-pointed star within a circle contained in applicant's mark is identical in sound, appearance and commercial impression to the marks in several of opposer's cited registrations, and wholly incorporates the entire mark in several of opposer's pleaded registrations. Furthermore, opposer claims that the descriptive wording "TEXAS KIDS" contained in applicant's mark does nothing to distinguish opposer's marks from the applicant's mark. Moreover, opposer maintains that it owns a family of well-known marks for footwear whose common identifier is a prominent five-pointed star and such ownership decreases the effectiveness of any distinguishing characteristics contained in applicant's mark.

In support of its arguments, opposer has submitted the following: (1) the declaration of Rebecca Culbertson-Booma, opposer's advertising manager, attesting to the fame of opposer's family of five-pointed star marks and to the amount

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of advertising conducted by opposer in promoting its family of five-pointed star marks, (2) the declaration of Robert Savoca, a buyer of footwear for Endicot Johnson Retail Corporation, a well-known retailer of footwear, attesting that the relevant public is likely to believe that applicant's mark is merely a member of opposer's family of five-pointed star marks; (3) copies of opposer's pleaded registrations; (4) selected newspaper and magazine articles and advertisements illustrating opposer's advertising and promotional efforts; (5) a list of celebrities who have endorsed opposer's goods sold under its family of five-pointed star marks; and (5) a copy of a federal court decision, *Starter v. Converse*, 1997 WL 391266 (S.D.N.Y. July 11, 1007), where the court entered a declaratory judgment on the jury's verdict which found that Starter's Corporation's marks, which contained a five-pointed star, when used on athletic footwear, would infringe upon opposer's family of five-pointed star marks for the same goods.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The fact that both parties have moved for summary judgment on the same issue, i.e. opposer's claim that applicant's mark is confusing similar to the marks in

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its pleaded registrations, does not, in itself, mean that no genuine issues of material fact remain. See *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

The determination of whether a likelihood of confusion exists is made by evaluating and balancing the *du Pont* evidentiary factors shown to be applicable to a particular case and for which evidence has been made of record. As noted in the *du Pont* decision itself, different factors may play a dominant role in any particular case. *In re E. I. du Pont de Nemours*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Indeed, our principal reviewing court and this Board have repeatedly held that, in an appropriate case, a single *du Pont* factor may be dispositive in the likelihood of confusion analysis. See, e.g., *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990); *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (dissimilarity of the marks under the first *du Pont* factor held dispositive); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (dissimilarity of the marks dispositive); *Sears Mortgage Corp. v. Northeast*

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Savings F.A., 24 USPQ2d 1227 (TTAB 1992) (dissimilarity between the marks dispositive).

We believe that the first *du Pont* factor, namely, the dissimilarity between the marks, is dispositive of this case. Considering the marks in their entireties, we are of the opinion that they differ so substantially in appearance, sound and connotation that there is no likelihood of confusion as a matter of law. Here, the applicant's five-pointed star design is merely background for the prominent wording, TEXAS KIDS. Moreover, the wording, TEXAS KIDS, assists in distinguishing the parties' marks and must be considered, despite applicant's disclaimer of the same. Finally, applicant's five-pointed star design is part of the overall cattle brand motif contained in applicant's mark. This Western motif connotes the State of Texas which in turn assists in linking the wording, TEXAS KIDS, to the image of the Lone Star State embodied in the five-pointed star in the Texas State flag. In view of such distinguishing characteristics, there can be no likelihood of confusion between the parties' marks as a matter of law. We would be of this opinion even if opposer offered evidence at trial that it has made prior and continuous use of its marks on its goods, that the goods move in the same channels of trade to the same classes of purchasers, that the involved goods are purchased casually rather than with care, and/or that

opposer's five-pointed star design is a well known or famous mark. In this case, the first *du Pont* factor simply outweighs all the other factors which might be pertinent.

Accordingly, we find that there are no genuine issues of material fact as to likelihood of confusion, and that applicant is entitled to judgment as a matter of law. Applicant's motion for summary judgment is hereby granted, opposer's cross-motion for summary judgment is denied, and the opposition is dismissed with prejudice. See Fed. R. Civ. P. 56(c) and (e). The application file shall be forwarded to registration in due course.³

T. J. Quinn

G. F. Rogers

L. K. McLeod
Administrative Trademark Judges
Trademark Trial and Appeal Board

³ In light of the instant order, applicant's alternative request for continuance under Fed. R. Civ. P. 56(f) is deemed moot.